

**REMARKS**

Reconsideration and allowance of the present application are respectfully requested. Claims 56-63 are now pending. Claims 61-63 have been added.

**REJECTION UNDER 35 U.S.C. §101**

Claims 56 and 60 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As set forth on page 12 of the Office Action, the Examiner asserts that claims 56 and 60 merely claim non-functional descriptive material stored on a medium, and, as such, fail to claim statutory subject matter. As amended, independent claim 56 recites a storage medium containing digital video information comprising video data units, wherein each video data unit has a control data packet containing control information for reproducing digital video information. Claim 56 specifies that a reproducing apparatus accesses said control data packet during a playback operation and uses such control information to reproduce the stored digital video information. As such, amended claim 56 relates to a storage medium that stores functional material (i.e., control information accessed by a reproducing apparatus to control reproduction of digital video information). Accordingly, Applicants submit that claim 56 recites statutory subject matter. Furthermore, claim 60 and 61 are believed to define statutory subject matter based on similar reasoning.

In review of the above, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. §101.

**REJECTION UNDER 35 U.S.C. §102**

Claim 56-60 stand rejected under 35 U.S.C. §102 as allegedly being anticipated by Fujinami et al. (U.S. Pat. No. 5,455,684). This rejection is respectfully traversed.

Independent claim 56 is directed to a storage medium containing digital video information obtained by coding a digital video signal using motion compensation prediction. The digital video information comprises intra-coded I-picture data, predictive-coded P-picture

data and bidirectionally predictive-coded B-picture data. The digital video information comprises video data units, each of which comprises a sequence of I-picture data, P-picture data and B-picture data. Each of the video data units has a control data packet containing control information for reproducing the digital video information, wherein the control information includes address information of the I-picture data and P-picture data in the video data unit. A reproducing apparatus accesses the control data packet during playback operation and uses the control information included in the control data packets to reproduce the digital video information.

Fujinami discloses a video/audio recording apparatus for recording encoded video/audio on a digital storage medium (DSM)10. The recording apparatus receives encoded video data compressed in accordance with the MPEG coding standard, such that the compressed video signal includes I, P, and B coded pictures. See eg., col. 6, lines 60-67; col. 12, lines 28-31. A header addition circuit 7, in cooperation with a control circuit 8, adds a video packet header to the video signal and an entry packet generation circuit 32 inserts an entry packet at a predetermined position in the video signal. Col. 11, lines 52-63. An entry packet is positioned to proceed a video packet consisting of a video packet header and a portion of the video signal that includes an I-picture. Col. 12, lines 19-24. Each entry pack includes information regarding distances between the current entry point and positions of proceeding and subsequent entry points, thereby enabling a high-speed search operation upon playing back from the DSM 10. Col. 13, lines 4-9; col. 19, lines 39-45.

Thus, the entry packet information in Fujinami is used to indicate entry points for a video packet that includes a I-picture but does not provide address information of P-picture data in a video data unit as required by claim 56.

According to MPEP § 2131, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claims.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

At least in view of the above, Applicants respectfully submit that Fujinami fails to anticipate claim 56. Claims 57-63 are believed to define of Fujinami based on similar reasoning.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the Examiners rejection under 35 U.S.C. §102.

#### **DOUBLE PATENTING REJECTIONS**

1. U.S. Patent No. 6,009,236/U.S. Patent No. 6,134,382/Co-Pending Application No. 10/083,267 in View of Fujinami.

Claims 56-60 stand rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Pat. No. 6,009,236 (“the ‘236 patent”) in view of Fujinami; further stand rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S Pat. No. 6,134,382 (“the ‘382 patent”) in view of Fujinami; and further stand provisionally rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of co-pending application no. 10/083,267 (“the ‘267 application”) in view of Fujinami. These rejections are respectfully traversed.

In rejecting claims 56-60 based on the allegedly obvious combination of ‘236 patent claims and Fujinami, the Examiner relies on Fujinami as allegedly teaching the feature of a control data packet that includes control information including address information of I-picture data and P-picture data in a video data unit. See Office Action, page 3. For reasons discussed above with respect to the rejection under 35 U.S.C. §102, however, Applicants submit that the entry point packet information disclosed in Fujinami fails to include address information for at least P-picture data in a video data unit. At least for this reason, the asserted combination of claims of the ‘236 patent and Fujinami fails to establish obviousness of any pending claim.

Similarly, the Examiners rejection of claims 56-60 based on an allegedly obvious combination of ‘382 patent claims and Fujinami relies on Fujinami as allegedly teaching control information including address information of I-picture data and P-picture data in a video data unit. See Office Action, page 6. As Fujinami fails to teach this claim feature, Applicants

respectfully submit that the asserted combination of claims of the '382 patent and Fujinami fails to establish obviousness of any pending claim.

With respect to the rejection of claims 56-60 based on an allegedly obvious combination of the '267 application claims and Fujinami, the Examiner again relies on Fujinami as allegedly teaching control information including address information of I-picture data and P-picture data in the video unit. See Office Action, page 9. As the entry packet information in Fujinami fails to include at least address information of P-picture data in a video unit, Applicants respectfully submit that the asserted combination of '267 application claims and Fujinami fails to establish obviousness of any pending claim.

2. U.S. Pat. No. 6,549,717.

Claims 56-60 stand rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Pat. No. 6,549,717. This rejection is respectfully traversed.

With respect to claim 2 of U.S. Pat. 6,549,717 ("the '717 patent"), the Examiner relies on claim 2 as allegedly being encompassed by claims of the present application. Applicants note, however, that claim 2 of the '717 patent fails to include the feature of control information including address information of I-picture data and P-picture data in a video data unit. As such, Applicants respectfully disagree with the Examiner's conclusion that claim 2 of the '717 patent is encompassed by the scope of any claim pending in the present application. Consequently, Applicants respectfully submit that claims in the present application are not rendered obviousness based on the claim 2 of the '717 patent. In view of the above, Applicants respectfully request reconsideration and withdrawal of the provisional and non-provisional rejections based on the doctrine of obviousness-double patenting.

**CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact D. Richard Anderson, Reg. No.

Application No. 10/083,475  
Amendment dated October 11, 2006  
Reply to Office Action of July 11, 2006

Docket No.: 1560-0375P

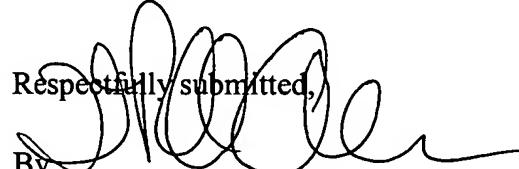
40,439 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 11, 2006

Respectfully submitted,

By

  
D. Richard Anderson  
Registration No.: 40,439  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant